



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/771,120	01/26/2001	Stefan Johansson	15292.4	7001

7590 04/05/2005
RICK D. NYDEGGER
WORKMAN NYDEGGER & SEELEY
1000 Eagle Gate Tower
60 East South Temple
Salt Lake City, UT 84145

EXAMINER

WAHBA, ANDREW W

ART UNIT	PAPER NUMBER
----------	--------------

2661

DATE MAILED: 04/05/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/771,120

Applicant(s)

JOHANSSON, STEFAN

Examiner

Andrew W Wahba

Art Unit

2661

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 23 September 2004.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-23 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-9, 11-21 and 23 is/are rejected.
- 7) ☒ Claim(s) 10 and 22 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 26 January 2001 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
- 1) ☒ Certified copies of the priority documents have been received.
 - 2) ☐ Certified copies of the priority documents have been received in Application No. _____.
 - 3) ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date <u>09/21/04</u> . | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Drawings

1. New corrected drawings are required in this application because elements in FIG 2 require labels that indicate the function of each step. Applicant is advised to employ the services of a competent patent draftsman outside the Office, as the U.S. Patent and Trademark Office no longer prepares new drawings. The corrected drawings are required in reply to the Office action to avoid abandonment of the application. The requirement for corrected drawings will not be held in abeyance.

Claim Rejections - 35 USC § 103

2. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

3. Claims 1, 3, 4, 5, 6, 7, 13, 15, 16, 17 and 18 are rejected under 35 U.S.C. 103(a) as being unpatentable over Sturniolo et al (6,154,461) in view of Eng et al (5,958,018).

With regard to claims 1 and 13, Sturniolo et al discloses an operating protocol for a mobile terminal roaming between LANs as illustrated by FIG 1. Sturniolo et al discloses that the mobile terminal 36 (wireless communication station) registers with an access point AP1 (wireless communication station) (column 6, lines 65-67). Sturniolo et al further discloses that the mobile terminal 36 establishes a session for communication with GATEWAY 1 to communicate (receiving/transmitting) with other devices (originator) in the communication system 20 (column 7, lines 40-43). As

illustrated by FIG 3, data packets include a source address (network address) that identifies (identity) the originator (column 3, lines 23-25).

Sturniolo et al, however, does not expressly disclose a determination step based upon the identity of the originator. Eng et al discloses a check as to whether an origination MAC address is registered upon receiving a MAC frame as illustrated by FIG 15 (column 4, lines 59-66).

A person of ordinary skill in the art would have been motivated to employ Eng et al in Sturniolo et al to identify a subset of mobile terminals such as those that are being served by an associated access processor (Eng column 4, lines 29-32). At the time the invention was made, therefore, it would have been obvious to one of ordinary skill in the art to which the invention pertains to combine the check as to whether an origination MAC address is registered as disclosed by Eng et al with communication system disclosed by Sturniolo et al (collectively Sturniolo-Eng) to obtain the invention specified in claims 1 and 13.

With regard to claims 3 and 15, the association of a network address with an identity is very common in mobile phones that associate a telephone number (address) with a name (identity).

With regard to claims 4 and 16, data packets (short message) include a source address (network address) as illustrated by FIG 3 (Sturniolo column 3, lines 23-25).

With regard to claim 5, 7 and 17, Sturniolo et al further discloses that the mobile terminal 36 establishes a session for communication (establishes a packet data session) with GATEWAY 1 to communicate (receiving/transmitting) with other devices

(originator) in the communication system 20 (column 7, lines 40-43). As illustrated by FIG 3, data packets include a source address (network address) that identifies (identity) the originator (column 3, lines 23-25).

With regard to claims 6 and 18, data packets include a source address (IP address) as illustrated by FIG 3 (Sturniolo column 3, lines 23-25).

With regard to claims 8, 9, 20 and 21, the name assigned to the originator would be the network server name in the event that the message originated from the network server. Network servers are typically identified by an Internet host domain name.

4. Claims 2, 11, 12, 14 and 23 are rejected under 35 U.S.C. 103(a) as being unpatentable over Sturniolo et al (6,154,461) in view of Eng et al (5,958,018) in further view of Koyama (5,654,957). Sturniolo-Eng does not disclose describe the makeup of the mobile station.

With regard to claims 2 and 14, Koyama discloses a packet communication unit that displays (displaying) arrived messages, address input scenes viewed by the user for the selection on the other party as well as a keyboard for inputting information required for operation (column 5, lines 21-27). Such a display would also display the identity of an incoming caller.

A person of ordinary skill in the art would have been motivated to employ the packet communication unit disclosed by Koyama in the mobile terminal disclosed by Sturniolo-Eng to provide a display in the mobile station (column 5, lines 21-27). At the time the invention was made, therefore, it would have been obvious to one of ordinary

skill in the art to which the invention pertains to combine Koyama with Sturniolo-Eng to obtain the invention in claim 2 and 14.

With regard to claim 11, the packet communication unit also includes a processor 31 (computer executable/microprocessor) in which a memory (computer-readable medium) is inherent (Koyama column 5, lines 39-45).

With regard to claim 12 and 23, Koyama et al further discloses that the packet communication unit also includes a processor 31 (processing means) in which a memory (memory means) inherent (Koyama column 5, lines 39-45). Koyama also disclose a keyboard for inputting information required for operation (Koyama column 5, lines 21-27).

Allowable Subject Matter

5. Claims 10 and 22 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

Response to Arguments

6. Applicant's arguments filed 09/23/2004 have been fully considered but they are not persuasive. The applicant argues that claimed steps are performed at the access point and not at the mobile terminal. (remarks, page 12, lines 8-11 and 14-16). The applicant, however, claims steps performed at a wireless communication station. The access point or base station is a wireless communication station.


Art Unit: 2661

7. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Andrew W Wahba whose telephone number is (571) 272-3081. The examiner can normally be reached on M-F 8:30-5:30.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Chau T Nguyen can be reached on (571) 272-3126. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Respectfully Submitted,

Andrew Wahba 
Patent Examiner
April 1, 2005



CHAU NGUYEN
SUPERVISORY PATENT EXAMINER
TECHNOLOGY CENTER 2600